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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,792	08/05/1999	SANDRA L. STANDIFORD	10981001-1	5929

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HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER

TRAN, THAI Q

ART UNIT PAPER NUMBER

2615

DATE MAILED: 07/08/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/368,792

Applicant(s)

STANDIFORD ET AL.

Examiner

Thai Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. In view of the Appellant's Brief filed on April 13, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Objections***

2. Claims 1-9 and 19-20 are objected to because of the following informalities:

Regarding claim 1, line 6, the feature "said at least one converter" should be change to --said converter--.

Claims 2-9 are dependent on the objected base claim 1 and; therefore, inherit the deficiencies thereof.

Regarding claim 19, line 7, the feature "said digital storage medium" should be changed to --said one of the CD recorder and the DVD recorder--.

Claim 20 is dependent on the objected base claim 19 and; therefore, inherit the deficiencies thereof. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 6-8, and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang (U.S. Patent No. 4,963,995).

Regarding claim 1, Lang discloses an apparatus (Figs. 1-2) for converting analog video data into digital form, the apparatus comprising:

an analog video cassette player (an audio/video recording unit (AVRU) 11 of Fig. 2, col. 3, lines 38-45) for producing analog video output;

an analog to digital converter (an analog to digital converter (ADC) 24 of Fig. 2, col. 4, lines 17-27 and 48-62) for converting said analog video output into digital data;

at least one recorder (memory 13 of Fig. 2, col. 6, lines 8-19 and col. 9, lines 1-30) employing a digital storage medium for storing said digital data, wherein said cassette player, said at least one converter and said storage medium are disposed within a single container (Fig. 1); and

a key frame marker (selecting point where other frames are to be inserted into the program disclosed in col. 6, lines 40-48) for inserting at least one marker into the digital data.

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Regarding claim 2, Lang also discloses the claimed a video port (video line or camera input line 15 and TV RF tuner 16 of Fig. 2, col. 3, lines 28-37) for receiving analog video information from an external source.

Regarding claim 6, Lang discloses the claimed wherein the digital storage medium is selectable by the user (col. 6, lines 8-14).

Regarding claim 7, Lang further discloses the claimed wherein the key frame marker marks abrupt changes in video image sequences, thereby enabling a user to readily locate a beginning and an end of a particular video sequence (rearrange the scenes in a movie disclosed in col. 6, lines 23-29).

Regarding claim 8, Lang discloses the claimed wherein the key frame marker marks positions in a sequence of said digital data at selectable time intervals (rearrange the scenes in a movie disclosed in col. 6, lines 23-29 and selecting point where other frames are to be inserted into the program disclosed in col. 6, lines 40-48).

Regarding claim 10, Lang discloses a method (Fig. 1) for preserving analog video data in digital form, the method comprising the steps of:

producing analog video output from an analog video tape (an audio/video recording unit (AVRU) 11 of Fig. 2, col. 3, lines 38-45);

converting said analog video output into digital video data (an analog to digital converter (ADC) 24 of Fig. 2, col. 4, lines 17-27 and 48-62);

storing said digital video data in a non-volatile digital storage medium thereby protecting said data against degradation over time (memory 13 of Fig. 2, col. 6, lines 8-19 and col. 9, lines 1-30); and

providing a single container to perform the steps of producing, converting, and storing (Fig. 1).

Regarding claim 11, Lang discloses the claimed step of deterring a required digital storage format prior to said step of converting based upon detection of a format of an inserted storage medium (col. 6, lines 8-14).

Regarding claim 12, Lang discloses the claimed inserting at least one marker in said digital video data to identify abrupt changes in video scenery, thereby enabling a user to readily identify particular video sequences during playing of said digital video data (rearrange the scenes in a movie disclosed in col. 6, lines 23-29 and selecting point where other frames are to be inserted into the program disclosed in col. 6, lines 40-48).

Regarding claim 13, Lang discloses the claimed inserting at least one marker in said digital video data at selectable time intervals, thereby enabling a user to readily move to selected chronological points in a video sequence during playing of said digital video data (rearrange the scenes in a movie disclosed in col. 6, lines 23-29 and selecting point where other frames are to be inserted into the program disclosed in col. 6, lines 40-48).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3-5, 9, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (U.S. Patent No. 4,963,995).

Regarding claim 3, Lang discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the video cassette player employs a VHS format.

Lang also discloses from col. 3, line 38 to col. 4, line 16 that the audio/video recording unit 11 may be a video cassette recorder similar to a conventional VCR in which the storage media 23 is a magnetic tape and AVRU 11 may operate with other types of storage media including but not limited to other magnetic tape formats, CD-ROM, WORM, and an erasable optical discs.

It is noted that video cassette player employs VHS format is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known VHS cassette tape into Lang's system since it

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merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 4, Lang discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the digital storage medium is one of a CD-R or a CD-RW.

Lang also discloses in col. 6, lines 8-19 that different types of memory technologies are adaptable for use in memory 13 such as DRAM, SRAM, CMOS, and optical disc memories.

It is noted that CD-R or CD-RW is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known CD-R or CD-RW into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 5, Lang discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the digital storage medium is a recordable DVD.

Lang also discloses in col. 6, lines 8-19 that different types of memory technologies are adaptable for use in memory 13 such as DRAM, SRAM, CMOS, and optical disc memories.

It is noted that DVD is old and well known in the art and; therefore, Official Notice is taken.



It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known DVD player into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 9, Lang discloses all the claimed limitations as discussed in claim 1 above except for providing wherein the video cassette player employs the 8 mm format.

Lang also discloses from col. 3, line 38 to col. 4, line 16 that the audio/video recording unit 11 may be a video cassette recorder similar to a conventional VCR in which the storage media 23 is a magnetic tape and AVRU 11 may operate with other types of storage media including but not limited to other magnetic tape formats, CD-ROM, WORM, and an erasable optical discs.

It is noted that video cassette player employs 8 mm format is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known 8 mm cassette tape into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 14, Lang discloses all the claimed limitations as discussed in claim 10 above except for providing wherein the digital storage medium is one of a CD-R or a CD-RW.

Lang also discloses in col. 6, lines 8-19 that different types of memory technologies are adaptable for use in memory 13 such as DRAM, SRAM, CMOS, and optical disc memories.

It is noted that CD-R or CD-RW is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known CD-R or CD-RW into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 15, Lang discloses all the claimed limitations as discussed in claim 10 above except for providing wherein the digital storage medium is a recordable DVD.

Lang also discloses in col. 6, lines 8-19 that different types of memory technologies are adaptable for use in memory 13 such as DRAM, SRAM, CMOS, and optical disc memories.

It is noted that DVD is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known DVD player into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

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Regarding claim 16, Lang discloses all the claimed limitations as discussed in claim 10 above except for providing wherein the digital storage medium is digital tape.

Lang also discloses in col. 6, lines 8-19 that different types of memory technologies are adaptable for use in memory 13 such as DRAM, SRAM, CMOS, and optical disc memories.

It is noted that digital tape recorder is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known digital tape recorder into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 17, Lang discloses all the claimed limitations as discussed in claim 10 above except for providing wherein the video cassette player employs a VHS format.

Lang also discloses from col. 3, line 38 to col. 4, line 16 that the audio/video recording unit 11 may be a video cassette recorder similar to a conventional VCR in which the storage media 23 is a magnetic tape and AVRU 11 may operate with other types of storage media including but not limited to other magnetic tape formats, CD-ROM, WORM, and an erasable optical discs.

It is noted that video cassette player employs VHS format is old and well known in the art and; therefore, Official Notice is taken.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known VHS cassette tape into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 18, Lang discloses all the claimed limitations as discussed in claim 10 above except for providing wherein the video cassette player employs the 8 mm format.

Lang also discloses from col. 3, line 38 to col. 4, line 16 that the audio/video recording unit 11 may be a video cassette recorder similar to a conventional VCR in which the storage media 23 is a magnetic tape and AVRU 11 may operate with other types of storage media including but not limited to other magnetic tape formats, CD-ROM, WORM, and an erasable optical discs.

It is noted that video cassette player employs 8 mm format is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known 8 mm cassette tape into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 19, Lang discloses an apparatus (Figs. 1-2) for preserving analog video data in digital form, the apparatus comprising:

a video cassette player (an audio/video recording unit (AVRU) 11 of Fig. 2, col. 3, lines 38-45) for producing analog video output;

an analog to digital converter (an analog to digital converter (ADC) 24 of Fig. 2, col. 4, lines 17-27 and 48-62) for converting said analog video output into digital data thereby protecting said data against degradation of over time; and;

at least one recorder (memory 13 of Fig. 2, col. 6, lines 8-19 and col. 9, lines 1-30) for storing said digital data, wherein said cassette player, said analog to digital converter, and said at least one recorder are disposed within a single container (Fig. 1). However, Lang does not specifically disclose that the at least one recorder is one of a CD recorder and a DVD recorder.

Lang also discloses in col. 6, lines 8-19 that different types of memory technologies are adaptable for use in memory 13 such as DRAM, SRAM, CMOS, and optical disc memories.

It is noted that CD recorder or DVD recorder is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known CD recorder or DVD recorder into Lang's system since it merely amounts to selecting an alternative equivalent recording device because Lang teaches that different recording devices can be used.

Regarding claim 20, Lang also discloses the claimed a key frame marker (rearrange the scenes in a movie disclosed in col. 6, lines 23-29 and selecting point where other frames are to be inserted into the program disclosed in col. 6, lines 40-48) for inserting index markers in said digital data marking abrupt changes in video image sequences, and alternatively, at selectable time intervals.

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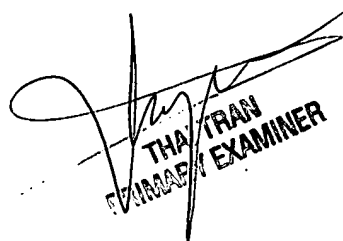
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725.

The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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THAI TRAN  
EXAMINER